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Colleen C. Lubking

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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP

901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER

MILEF, ELDA G

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/882,304
Filing Date: June 18, 2001
Appellant(s): LUBKING ET AL.

Arthur A. Smith
For Appellant

EXAMINER'S ANSWER

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This is in response to the appeal brief filed 6/29/2007 appealing from the Office action mailed 11/2/2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

NEW GROUND(S) OF REJECTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim(s) 17 is/are rejected under 35 USC § 112, ¶ 2, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim(s) recites/recite the following means (or step) plus function limitations:

(a) means for analyzing the received customer information using a filter that categorizes a customer into a life status, wherein the life status corresponds to the customer's demographic classification;

(b) means for selecting from a set of financial products, a first financial product for the customer based on said life status using a data structure that relates each life status type to a particular financial product;

(c) means for monitoring periodically, the customer information for changes;

(d) means for selecting, from the set of financial products, a second financial product for the customer based on said revised life status using the data structure that relates each life status type to a particular financial product;

(e) means for optimizing said first and second financial products based on said creditworthiness.

This limitation invokes 35 USC § 112, ¶ 6 because it meets the 3-prong analysis set forth in MPEP 2181 as it recites the phrase "means for" or "step for" (or appellant identifies the limitation as a means (or step) plus function limitation in the appeal brief) and the phrase is modified by functional language and it is not modified by sufficient structure, material, or acts for performing the recited

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function. Also see *Altiris Inc. v. Semantec Corp.*, 318 F.3d 1363, 1375 (Fed. Cir. 2003). 35 USC § 112, ¶ 6, requires such claim to be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof. “If one employs means plus function language in a claim, one must set forth in the specification an adequate disclosure showing what is meant by that language. If an applicant fails to set forth an adequate disclosure, the applicant has in effect failed to particularly point out and distinctly claim the invention as required by the second paragraph of section § 112.” *In re Donaldson Co.*, 16 F.3d 1189, 1195, 29 USPQ 1845, 1850 (Fed. Cir. 1994)(in banc.). For a computer-implemented means-plus-function claim limitation that invokes 35 USC § 112, ¶ 6, the corresponding structure is required to be more than simply a general purpose computer. *Aristocrat Technologies, Inc. v. International Game Technology*, 521 F.3d 1328, 1333, 86 USPQ2d 1235, 1239-40 (Fed. Cir. 2008). The corresponding structure for a computer-implemented function must include the algorithm as well as the general purpose computer. *WMS Gaming, Inc. v. International Game Technology*, 184 F.3d 1339, 51 USPQ2d 1385 (Fed. Cir. 1999). The written description must at least disclose the algorithm that transforms the general purpose microprocessor to a special purpose computer programmed to perform the claimed function. *Aristocrat*, 521 F.3d at 1338, 86 USPQ2d at 1242.

In the instant application, the following portions of the specification and drawings may appear to describe the corresponding structure for performing the claimed functions:

- (a) Fig. 2 and paragraph 34;
- (b) Figs. 4-5B;
- (c) Fig. 2 and paragraph 48;
- (d) Figs. 4-5B;
- (e) Figs. 1-2 and paragraphs 44 and 48.

However, the specification and drawings do not disclose sufficient corresponding structure, material or acts for performing the claimed function.

(a) It appears the claimed means are broadly defined in paragraph 34 of the specification and broadly shown in Fig. 2. However the specification does not specifically describe how the recited function is performed.

Specifically, the specification does not disclose one or more specific algorithms for implementing the claimed means on a machine. Therefore, Appellants have failed to adequately describe sufficient structure for performing the claimed means.

(b) It appears the claimed means are broadly shown in Fig. 4-5B. However the specification does not specifically describe how the recited function is performed.

Specifically, the specification does not disclose one or more specific algorithms for implementing the claimed means on a machine. Therefore,

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Appellants have failed to adequately describe sufficient structure for performing the claimed means.

(c) It appears the claimed means are broadly defined in paragraph 48 of the specification and broadly shown in Fig. 2. However the specification does not specifically describe how the recited function is performed.

Specifically, the specification does not disclose one or more specific algorithms for implementing the claimed means on a machine. Therefore, Appellants have failed to adequately describe sufficient structure for performing the claimed means.

(d) It appears the claimed means are broadly shown in Fig. 4-5B. However the specification does not specifically describe how the recited function is performed.

Specifically, the specification does not disclose one or more specific algorithms for implementing the claimed means on a machine. Therefore, Appellants have failed to adequately describe sufficient structure for performing the claimed means.

(e) It appears the claimed means are broadly defined in paragraphs 44 and 48 of the specification and broadly shown in Fig. 1-2. However the specification does not specifically describe how the recited function is performed.

Specifically, the specification does not disclose one or more specific algorithms for implementing the claimed means on a machine. Therefore,

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Appellants have failed to adequately describe sufficient structure for performing the claimed means.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,430,542	Moran	8-2002
2002/0023051	Kunzle et al.	2-2002

(9) Grounds of Rejection

1. The following ground(s) of rejection are applicable to the appealed claims:

Note: The after final amendment submitted by the Appellants on 1/29/2007 included the cancellation of claims 5, 6, 21, 22, 28, 29 which were rolled into the independent claims 1, 17, and 24. The rejection of the amended independent claims would therefore include the secondary reference and are rejected under 35 U.S.C. 103(a) as being unpatentable over Moran in view of Kunzle.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim(s) 17 is/are rejected under 35 USC § 112, ¶ 2, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim(s) recites/recite the following means (or step) plus function limitations:

(a) means for analyzing the received customer information using a filter that categorizes a customer into a life status, wherein the life status corresponds to the customer's demographic classification;

(b) means for selecting from a set of financial products, a first financial product for the customer based on said life status using a data structure that relates each life status type to a particular financial product;

(c) means for monitoring periodically, the customer information for changes;

(d) means for selecting, from the set of financial products, a second financial product for the customer based on said revised life status using the data structure that relates each life status type to a particular financial product;

(e) means for optimizing said first and second financial products based on said creditworthiness.

This limitation invokes 35 USC § 112, ¶ 6 because it meets the 3-prong analysis set forth in MPEP 2181 as it recites the phrase "means for" or "step for" (or appellant identifies the limitation as a means (or step) plus function limitation in the appeal brief) and the phrase is modified by functional language and it is not modified by sufficient structure, material, or acts for performing the recited function. Also see *Altiris Inc. v. Semantec Corp.*, 318 F.3d 1363, 1375 (Fed. Cir.

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2003). 35 USC § 112, ¶ 6, requires such claim to be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof. “If one employs means plus function language in a claim, one must set forth in the specification an adequate disclosure showing what is meant by that language. If an applicant fails to set forth an adequate disclosure, the applicant has in effect failed to particularly point out and distinctly claim the invention as required by the second paragraph of section § 112.” *In re Donaldson Co.*, 16 F.3d 1189, 1195, 29 USPQ 1845, 1850 (Fed. Cir. 1994)(in banc.). For a computer-implemented means-plus-function claim limitation that invokes 35 USC § 112, ¶ 6, the corresponding structure is required to be more than simply a general purpose computer. *Aristocrat Technologies, Inc. v. International Game Technology*, 521 F.3d 1328, 1333, 86 USPQ2d 1235, 1239-40 (Fed. Cir. 2008). The corresponding structure for a computer-implemented function must include the algorithm as well as the general purpose computer. *WMS Gaming, Inc. v. International Game Technology*, 184 F.3d 1339, 51 USPQ2d 1385 (Fed. Cir. 1999). The written description must at least disclose the algorithm that transforms the general purpose microprocessor to a special purpose computer programmed to perform the claimed function. *Aristocrat*, 521 F.3d at 1338, 86 USPQ2d at 1242.

In the instant application, the following portions of the specification and drawings may appear to describe the corresponding structure for performing the claimed functions:

- (a) Fig. 2 and paragraph 34;
- (b) Figs. 4-5B;
- (c) Fig. 2 and paragraph 48;
- (d) Figs. 4-5B;
- (e) Figs. 1-2 and paragraphs 44 and 48.

However, the specification and drawings do not disclose sufficient corresponding structure, material or acts for performing the claimed function.

(a) It appears the claimed means are broadly defined in paragraph 34 of the specification and broadly shown in Fig. 2. However the specification does not specifically describe how the recited function is performed.

Specifically, the specification does not disclose one or more specific algorithms for implementing the claimed means on a machine. Therefore, Appellants have failed to adequately describe sufficient structure for performing the claimed means.

(b) It appears the claimed means are broadly shown in Fig. 4-5B. However the specification does not specifically describe how the recited function is performed.

Specifically, the specification does not disclose one or more specific algorithms for implementing the claimed means on a machine. Therefore, Appellants have failed to adequately describe sufficient structure for performing the claimed means.

(c) It appears the claimed means are broadly defined in paragraph 48 of the specification and broadly shown in Fig. 2. However the specification does not specifically describe how the recited function is performed.

Specifically, the specification does not disclose one or more specific algorithms for implementing the claimed means on a machine. Therefore, Appellants have failed to adequately describe sufficient structure for performing the claimed means.

(d) It appears the claimed means are broadly shown in Fig. 4-5B. However the specification does not specifically describe how the recited function is performed.

Specifically, the specification does not disclose one or more specific algorithms for implementing the claimed means on a machine. Therefore, Appellants have failed to adequately describe sufficient structure for performing the claimed means.

(e) It appears the claimed means are broadly defined in paragraphs 44 and 48 of the specification and broadly shown in Fig. 1-2. However the specification does not specifically describe how the recited function is performed.

Specifically, the specification does not disclose one or more specific algorithms for implementing the claimed means on a machine. Therefore, Appellants have failed to adequately describe sufficient structure for performing the claimed means.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 14, 17, 24, 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moran (US Patent No. 6,430,542).

Re claim 1: Moran discloses:

receiving customer information from an application database ("the Persistence subsystem 232 preferably interfaces with a relational database management system (RDMS)238...Preferably, FAS 10 allows inter alia client data to be entered...The exporting and importing of files between advisors is preferably accomplished by the exporting of a client as an 'economic group'...")- see col. 6 lines 21-67, and Figs. 2 and 4. It is obvious from the teachings of Moran that the databases maintained by the financial advisors contain customer information provided by the customer per requests from the financial product provider for information.;

analyzing the received customer information using a filter that categorizes a customer into a life status, wherein the life status corresponds to the customer's demographic classification ("In general, Economic Group 200 reflects

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the demographics of the group for which the planning is being done...Thus, Plan 235 preferably constructs those text, table, and graphic outputs desired in a financial proposal...The Economic Groups 200 subsystem is preferably the portion of FAS 10 which represents the target of the advisor's financial planning activities...FAS10 preferably further subdivides EG 200...into demographically narrowing classifications")-see col. 11 line 36-col. 12 line 28;

selecting, from a set of financial products, a first financial product for the customer based on said life status using a data structure that relates each life status type to a particular financial product ("While FAS 10 prefers only one EG200 exists per planning scenario...")-see col. 14 lines 35-42, and col. 15 lines 9-20;

monitoring, periodically, the customer information for changes; automatically revising, based on a change to the customer information, the customer's life status-see col. 14 lines 43-54;

selecting, from the set of financial products, a second financial product for the customer based on said revised life status using the data structure that relates each life status type to a particular financial product-see col. 14 lines 43-67, and "alternative view" col. 28 lines 45-65.

Also, see Figure 16 and related text.

Re claim 14: Moran discloses periodically receiving said customer information-see col. 13 line 36- col. 14 line 67, col. 23 lines 50-56.

Re claims 17: Further a system would have been necessary to perform the method of previously rejected claim 1 and is therefore rejected using the same art and rationale.

Re claim 24: Moran discloses a computer, with a memory having program instructions and a processor configured to perform the remaining steps of claims 1 and 17. –see Figs. 1, 2, 4 and cols. 6 and 7 and claims 1 and 17 above.

Re claims 31-33: Moran discloses a method, system, and computer for providing a financial product to a customer wherein the data structure comprises an algorithm.-see cols. 11-12.

6. Claims 5-7, 13, 21-23, 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moran in view of Kunzle (PG. Pub. No. 2002/0023051).

Re claims 5-7, 13: Although Moran discloses offering multiple financial plans per group in col. 14 lines 35-42, Moran does not specifically disclose determining the creditworthiness of the customer; optimizing and offering said first and second financial products based on said creditworthiness. Kunzle however, teaches (“The system may also approve a customer for a recommended financial product...Preferably, these terms are set based upon the creditworthiness or financial condition of the customer...The system also enables customers to select and accept one or more other financial products from the one

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or more financial products recommended...”)–see pars. 26 and 27. It is obvious that the invention disclosed by Kunzle is optimizing the first and second financial products because the system will approve the customer based on creditworthiness, therefore, the system will offer products that reduce credit risk to the financial institution. Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Moran to include determining the creditworthiness of a borrower as taught by Kunzle in order for the financial institution to reduce credit risk.

Re claims 21-23: Further a system would have been necessary to perform the method of previously rejected claims 5-7 and are therefore rejected using the same art and rationale.

Re claims 28-30: Further a computer would have been necessary to perform the method of previously rejected claims 5-7 and are therefore rejected using the same art and rationale.

(10) Response to Argument

Appellants’ pre-KSR brief argues that there is no teaching suggestion or motivation to combine Moran and Kunzle et al. *KSR* forecloses Appellants’ argument that a specific teaching is required for a finding of obviousness. *KSR*, 127 S. Ct. at 1741, 82 USPQ2d at 1396.

Claims 1, 7,13,14,17,23,24,30-33 recite combinations which only unite old elements with no change in their respective functions and which yield predictable

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results. Thus, the claimed subject matter likely would have been obvious under *KSR*. In addition, neither the Appellants' Specification nor Appellants' arguments present any evidence that modifying Moran with the selected elements of Kunzle was uniquely challenging or difficult for one of ordinary skill in the art. Under those circumstances, the Examiner did not err in holding that it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Moran to include the approving a customer for a recommended financial product based upon the creditworthiness of the customer, and the system enabling customers to select and accept one or more financial products from those recommended as taught by Kunzle to allow for the reduction of credit risk to the financial institution. Because this is a case where the improvements are no more than the predictable use of prior art elements according to their established functions, no further analysis is required by the Examiner. *KSR*, 127 S. Ct. at 1740, 82 USPQ2d at 1396.

Regarding the Appellants' suggestion that Moran does not teach or suggest a financial product. The Appellants' attention is directed to col. 1 lines 21-50 wherein Moran discloses that the preparation of a financial plan involves eventually conducting financial transactions for clients, and that financial advisors are aware of the financial products which are provided by his or her company in order to address the client's questions and concerns. Furthermore, Moran discloses displaying to the customer recommendations including specific financial products (Figure 49).

In response to the Appellants' argument that Moran does not disclose or suggest that a change in the economic group results in the "selecting, from the set of financial products, a first financial product for the customer... Using a data structure that relates each life status type to a particular financial product." The Appellants' attention is directed to col. 14, lines 35-54 wherein Moran discloses a financial advisory service (FAS) providing the generation of multiple financial plans per group. Moran further discloses ("As group members change over time (due to death, marriage, job changes, or the like), FAS 10 is configured to suitably notify other FAS 10 program elements of the changes. For example, when a group member gets married, the member's change in marital status may lead to change in the member's tax position and may necessitate an updating of the group's associated income tax goal. As shown in Fig. 16, FAS 10 preferably ensures these changes are accomplished by broadcasting the change in the Domain Object (the member's marital status) to the Lifetime Situation (LIFE) 256, and an associated FP 237. LIFE 256 and FP 237 are preferably updated to reflect these changes.") [Financial Position (FP)].

In response to Appellants' argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*,

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443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case, both Moran and Kunzle are analogous prior art references both disclosing financial planning methods and systems.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section **(9)** above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) Reopen prosecution. Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) Maintain appeal. Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed

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pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

/Elda Milef/

Examiner, Art Unit 3694

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

/Wynn Coggins/

Director, TC 3600

Conferees:

/James P Trammell/

Supervisory Patent Examiner, Art Unit 3694

Vincent Millin/vm/
Appeals Practice Specialist